

Applicants have surprisingly discovered that varying the content of the binder can have an effect on the properties of the non-aqueous electrolyte secondary battery of the present invention. As shown in Table 2 on page 19 of the specification, Applicants have demonstrated that a binder content ranging from about 2% to about 15% results in a non-aqueous electrolyte secondary battery that has an enhanced initial capacity and short circuits at elevated temperatures. Indeed, the comparative example of Table 2 (e.g., sample 8) has a binder content of about 1 weight percent, yet it results in a non-aqueous electrolyte secondary battery that displays a capacity and a short circuit temperature which are appreciably less than that of a secondary battery which has a binder content ranging from about 2% to about 15% as required by the claimed invention.

Applicants respectfully submit that *Koichiro* fails to teach or arguably suggest a number of features of the claimed invention. For example, Applicants believe that *Koichiro* fails to teach or suggest the binder weight percentage feature of the claimed invention. In this regard, the Patent Office merely asserts, without any apparent support, that the binder weight percentage feature would be obvious to one of ordinary skill in the art.

Applicants respectfully submit that the mere conclusory statements with respect to *Koichiro* are insufficient to overcome its prima facie burden. Of course, it is "impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992). Although one of skill in the art might find it "obvious to try" the binder weight percentage features of the claimed invention, an "obvious to try" analysis is not the proper standard under 35 U.S.C. §103. *In re Geiger*, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987). Indeed, an "obvious to try" test would often deny patent protection to inventions growing out of

well-planned research which is, of course, guided into those areas in which success is deemed most likely. *In re Lindell*, 155 USPQ 521, 523 (C.C.P.A. 1967).

As previously discussed, Applicants have surprisingly discovered that a non-aqueous electrolyte secondary battery that has a binder weight percentage ranging from about 2% to about 15% exhibits enhanced properties including, for example, capacity and short circuit temperature as disclosed in the specification on pages 19-21. Applicants believe that nowhere does the *Koichiro* abstract teach or suggest the specific binder weight percentage features of the claimed invention, let alone recognize the beneficial effects with respect to such features.

Based on the apparent differences between the claimed invention and *Koichiro*, Applicants respectfully submit that *Koichiro* fails to teach or suggest a number of features of the claimed invention. Therefore, Applicants respectfully submit that *Koichiro* fails to render obvious the claimed invention as required by Claims 7-9 and 16.

Accordingly, Applicants respectfully request that this rejection be withdrawn.

In the Office Action, Claims 12-15 are rejected under 35 U.S.C. §103 in view of *Koichiro* and Japanese Patent Document No. 4-195201 ("*Abe*"). The Patent Office primarily relies on *Koichiro* and therefore relies on *Abe* to remedy the deficiencies of *Koichiro*.

Applicants respectfully submit that this rejection is improper. Claims 12-15 depend from independent Claim 7 and therefore as a matter of law incorporate each of the features of independent Claim 7.

With respect to *Koichiro*, Applicants respectfully submit that *Koichiro* is clearly deficient with respect to the claimed invention, particularly with respect to the binder weight percentage features as required by independent Claim 7 and discussed above.

Further, Applicants respectfully submit that the Patent Office cannot rely solely on *Abe* to remedy the deficiencies of *Koichiro*. In this regard, the Patent Office merely relies on *Abe* for its alleged teachings with respect to the cellulose derivative and graphite features of Claims 12-15. Moreover, nowhere does *Abe* teach or suggest the binder weight percentage features of the claimed invention.

Based on the fact that *Koichiro* and *Abe*, even if combinable, fail to teach or suggest a number of features of the claimed invention, Applicants respectfully submit that these references, alone or even if combinable, fail to render obvious the claimed invention. Accordingly, Applicants respectfully request that this rejection be withdrawn.

For the foregoing reasons, Applicants respectfully submit that the above-identified patent application is now in a condition for allowance and earnestly solicit reconsideration of same.

Respectfully submitted,

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